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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,370	03/29/2001	Todd P. Beach	TMADE.067A	3442

7590 07/02/2003  
Sheppard Mullin Richter & Hampton LLP  
333 South Hope Street  
48th Floor  
Los Angeles, CA 90071

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

12

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/821,370

Applicant(s)

BEACH ET AL.

Examiner

Sebastiano Passaniti

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 08 April 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3711

### DETAILED ACTION

This Office action is responsive to communication received 04/08/2003 – Revocation and Power of Attorney, Amendment A, Drawings, Letter and Declarations, Request for three month extension of time; 05/13/2003 – Revocation and Power of Attorney.

The examiner of record in this application has changed. Updated correspondence information may be found at the end of this Office action.

Claims 1-29 remain pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama ('132) in view of Hasebe ('494), Tom ('148) and Masghati ('961). The patent to Yoneyama discloses the invention substantially as claimed and includes a

Art Unit: 3711

plurality of weights aligned along a front/back axis that extends generally perpendicular to the striking face and below the horizontal centerline of the head, as required by claims 22-25 and 29. See Figures 1 and 2 in Yoneyama. Further, the Yoneyama reference recognizes a relationship between head volume and the weight of the balance weight, noting that a lowering of the center of gravity through an adjustment of the volume and weight of the balance weight may enhance ball carry and trajectory. See col. 2, lines 6-15 along with col. 3, line 47 through col. 4, line 11 in Yoneyama.

However, the Yoneyama patent differs from the claimed invention in that Yoneyama does not detail the specifics of the moment of inertia along a horizontal axis, as required by claims 1, 2 and 4 along with a second moment of inertia about a vertical axis, as required by claims 20 and 21, and a disclosed and specific location for the center of gravity with respect to the horizontal centerline of the head and the centerline of the shaft, as further required by claims 3, 9, 10, 12-14 and 17-19. The teaching references recognize that the location of the center of gravity with respect to the location of the hosel and the horizontal centerline of the club directly affects the value of the moment of inertia as well as the amount of ball carry. For instance, see col. 2, line 7 through col. 3, line 13 in Hasebe. For example, Tom notes that the center of gravity may be placed on or below a plane containing the center of gravity of the head and rearward of the shaft centerline by a predetermined amount in order to maximize the moment of inertia and minimize the tendency of the head to rotate. See col. 3, lines 41-54 in Tom. Using the collective teachings of Yoneyama, Hasebe and Tom, it is clear that the art has recognized that there exists a recognition that the values of the moment of inertia,

Art Unit: 3711

location of the center of gravity with respect to both the horizontal centerline and the shaft axis as well as the actual volume of the head and mass of any balance weight may be selected dependent upon what is considered convenient. In other words, the variables are recognized as being result-effective. Where a parameter(s) optimized is recognized as being result-effective, that optimization is normally considered an obvious matter to one having ordinary skill in the art. See In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Under the circumstances here, it is believed that the applicant's claimed dimensions involve no more than the optimization of a result-effective variable(s) and would have been obvious to one having ordinary skill in the art, based upon the teachings of Yoneyama, Hasebe and Tom. Of further interest is that the applicant has not detailed that the claimed parameters are for any unobvious purpose. In fact, the applicant specifically notes that the combination of moment of inertia values along with head volumes and dimensional distances detailing the location of the center of gravity are established in order to lower the center of gravity to improve ball carry. Varying these parameters for the reason given by the applicant is well established in the prior art cited above. Thus, the claimed dimensions are not deemed critical.

Claims 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoneyama ('132). Reference is made to Figures 1, 2 and the description in col. 2, lines 6-15 and col. 3, line 48 through col. 4, line 11.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figures 4 and 5 in Thompson. Bowland and Churchward show weights in the sole, of interest.

The drawings correction received 04/08/2003 lacks a marked-up version showing the changes made in red ink.

#### RESPONSE TO ARGUMENTS


Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-7768 for After Final communications.

Art Unit: 3711

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
June 30, 2003